

Serial No. 10/784,898**PATENT/OFFICIAL****REMARKS**

In the Office Action, the Examiner noted that claims 1-20 are pending in the application, and that claims 1-20 are rejected. By this Amendment, claims 1-20 are cancelled without prejudice or disclaimer, and claims 21-38 have been added. Thus, claims 21-38 are pending in the application. No new matter is believed to have been added by these new claims.

Applicants respectfully traverse the rejections by the Examiner.

Objection of the Specification

The Specification is objected to due to informalities. Applicants have amended the Abstract, as provided herein. Accordingly, Applicants respectfully request that this objection be withdrawn.

Rejection Under 35 U.S.C. § 103(a)

Claims 1-20 are rejected as being obvious in view of U.S. Patent 5,594,638 to Iliff, entitled "Computerized medical diagnostic system including re-enter function and sensitivity factors." Applicants respectfully traverse this rejection as it may relate to, if at all, new Claims 21-38. Applicants do not concede, however, that the Examiner's description of Iliff has any direct relevancy to the patentability of Claims 1-20.

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Iliff relates to a patient medical problem diagnosing method for automated medical advice system. The method involves executing additional diagnostic consultation in response to stored patient information and indicator of satisfied re-enter criteria. The medical advice is provided to the general public over a telephone network. Two new authoring languages, interactive voice response and speech recognition are used to enable expert and general practitioner knowledge to be encoded for access by the public. "Meta" functions for time-density analysis of a number of factors regarding the number of medical complaints per unit of time are an integral part of the system. A semantic discrepancy evaluator routine along with a mental status examination are used to detect the consciousness level of a user of the system. A re-enter feature monitors the user's changing condition over time. A symptom severity analysis helps to respond to the changing conditions. System sensitivity factors may be changed at a global level or other levels to adjust the system advice as necessary.

In contrast, the claimed invention of the present application is a method (and a system) that provides, in at least one embodiment of the invention, among other features, a comprehensive and in-depth set of information to an operator, prior to diagnosis by a physician, in providing medical services to a caller regarding at least one pharmaceutical that the caller is currently using.

The combination of features of, for example, new claim 21 allows the operator to provide, efficiently and economically, integrated decision support to gather, maintain and update medical, pharmaceutical, demographic, psycho-graphic, and health benefit information of

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members and to maintain and provide medical, pharmaceutical, and customer service information and advice to the caller.

Applicant respectfully submits that none of the cited references, either alone or in combination, teaches or suggests the combination of features as required in claim 21. For example, on page 4 of the Office Action, the Examiner admits that Iliff fails to disclose the claimed feature of "the use of an operator as an intermediary between the computer system and the caller; however, Iliff does allude to the existence of such an operator." Applicant respectfully disagrees, particularly with reference to the currently claimed combination of features of the present invention.

In addition, on page 5 of the Office Action, the Examiner admits that Iliff "does not expressly teach the step of writing drug prescriptions (including refills or renewals); however official notice is taken that it is old and well known in the art to have prescriptions called in by a doctor's office on a patient's behalf." Applicant disagrees that this Official Notice is sufficiently related to the claimed feature, and respectfully request the Examiner to provide a prior art reference showing this feature or an Affidavit under 37 C.F.R. 1.104(d)(2). In the absence of either, Applicant requests the Examiner to withdraw the rejection.

Similarly, on page 5 of the Office Action, the Examiner admits that Iliff "does not explicitly include a record of advice given in previous sessions with the caller." In addition, on page 6 of the Office Action, the Examiner admits that Iliff refers to patients to doctors and he provides advice directly to the callers (col. 41, lines 12-45) but he doesn't explicitly disclose

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sending this advice to doctors directly." Accordingly, for these reasons as well, Applicant respectfully submits that currently claimed combination patentably distinguishes over Iliff.

Further, the following is a list of additional missing features in the cited references. The following list is exemplary, and should not be construed as meaning that additional differences between the claimed invention and the prior do not exist. In fact, other differences will also be apparent to one of ordinary skill. For example, the following features are asserted to be missing from Iliff: determining a new action using the member profile information including the health benefit plan information, the prescription drug history, the self-reported health information, and the recent contact history when at least one of the clinical information, the pharmaceutical information and the health benefit information are updated; providing one or more operators with member profile information associated with the caller including health benefit plan information, prescription drug history, self-reported health information, and recent contact history, including, when present, a list of allergies, prescriptions, and pre-existing health conditions associated with the caller; and/or generating reports with respect to the health related issue and notices including information collected during the communication with the caller, combined with specific pharmacy information, for delivery to the physician of the caller, and the caller's health plan with respect to the health related issue.

In addition, dependent claims 22-35, which depend, directly or indirectly, from independent claim 21, and incorporate the limitations of claim 21, as well as independent claims 36-38, also include additional limitations that are not shown or suggested by the prior art. Applicants respectfully submit that dependent and independent claims 22-38 patentably

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distinguish over the prior art. Withdrawal of this rejection for these reasons as well as respectfully requested.

Applicants believe all pending claims are in the form to be allowed. An early notice is earnestly solicited.

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Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

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Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicants reserve the right to further prosecute these claims in continuing applications. In addition, Applicants have attempted to claim all embodiments disclosed in the present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

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For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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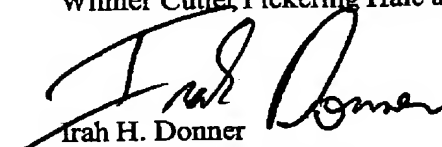
Serial No. 10/784,898PATENT/OFFICIALAUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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